

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:)
LAVERICK, DAVID J.)
Serial No.: 10/663,045)
Filed: September 13, 2003)
NAVIGATIONAL DEVICE FOR MOUNTING)
ON A SUPPORT PILLAR OF A VEHICLE)
AND METHOD FOR DOING SAME)
Attorney Docket No.:
702.276
Group Art Unit No. 3663
Examiner: DIACOU, Ari M.

APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:)
LAVERICK, DAVID J.)
Serial No.: 10/663,045) Attorney Docket No.:
Filed: September 13, 2003) 702.276
NAVIGATIONAL DEVICE FOR MOUNTING)
ON A SUPPORT PILLAR OF A VEHICLE) Examiner: DIACOU, Ari M.
AND METHOD FOR DOING SAME)

APPELLANT'S BRIEF ON APPEAL

In response to the Advisory Action dated August 31, 2007, and the Notice of Appeal dated September 26, 2007, Appellant's Brief on Appeal in accordance with 37 C.F.R. § 41.37 is hereby submitted. The Examiner's rejections of claims 1-7 and 23-30 are herein appealed, and allowance of said claims is respectfully requested.

The Commissioner is hereby authorized to charge the \$500 fee for this Appeal Brief, and any additional fees which may be required, or credit any overpayment, to Account No. 501-791.

Respectfully submitted,

By: /Samuel M. Korte/
Samuel M. Korte, Reg. No. 56,557
Garmin International, Inc.
1200 East 151st Street
Olathe, KS 66062
(913) 440-5421
(913) 397-9079 (Fax)

Appeal of U.S. Application No. 10/663,045
Appeal Brief

Following are the requisite statements under 37 C.F.R. § 41.37:

I. Real Party in Interest

David J. Laverick and Brian G. Schoenfish are the inventors of the claimed invention. The inventors assigned the above-referenced application to Garmin Ltd., the Real Party in Interest.

II. Related Appeals and Interferences

U.S. Patent Application entitled “NAVIGATIONAL DEVICE FOR INSTALLATION IN A VEHICLE AND A METHOD OF DOING SAME”, Serial No. 11/051,879, filed February 5, 2005 is related to the instant application and is also under Appeal.

III. Status of Claims

Claims 1-7 and 23-30 stand rejected and appealed. Claims 8-21 have been withdrawn. Claim 22 has been canceled.

IV. Status of Amendments

All amendments submitted by the Appellant have been entered.

V. Summary of Claimed Subject Matter

The claimed embodiments of the present invention are directed to a navigation assembly for use in a vehicle not originally equipped with navigational capabilities.

Claim 1 recites “[a] navigation assembly for use in a vehicle not originally equipped with navigational capabilities”, page 11, lines 9-11, page 24, lines 23-28, and figures 19-22, item 177k; “the navigation assembly comprising: a portable navigational device”, page 11, lines 5-8, page 24, lines 28-31, and figures 19-22, item 10k; and “a mounting assembly for mounting on a support pillar of the vehicle and sized and configured to removably receive the navigational device”, page 11, lines 3-5, page 24, line 31, though page 25, line 3, and figures 19-22, item 194k, “wherein the navigation

Appeal of U.S. Application No. 10/663,045
Appeal Brief

device remains visible when received within the mounting assembly and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly”, as described on page 27, line 27, through page 28, line 3, and shown best in figure 19.

Claim 24 recites “[a] navigation assembly for use in a vehicle not originally equipped with navigational capabilities”, page 11, lines 9-11, page 24, lines 23-28, and figures 19-22, item 177k; “the navigation assembly comprising: a stand-alone hand-held portable navigational device”, page 11, lines 5-8, page 24, lines 28-31, and figures 19-22, item 10k; and “a mounting assembly for mounting on an existing support pillar of the vehicle and sized and configured to mate with the support pillar and removably receive the navigational device”, page 11, lines 3-5, page 24, line 31, though page 25, line 3, and figures 19-22, item 194k, “such that the navigation device remains visible and fully functional when received within the mounting assembly”, as described on page 27, line 27, through page 28, line 3, and shown best in figure 19.

Thus, various claimed embodiments of the present invention provide a navigation assembly for use in a vehicle not originally equipped with navigational capabilities.

Appellants note that the page and paragraph numbers cited above are for reference purposes only and should not be taken as a limitation on the support for, nor scope of, the claimed subject matter. Support for the claimed subject matter may be found throughout the specification and drawings and the page and line numbers cited above merely refer to exemplary portions of the specification.

Appeal of U.S. Application No. 10/663,045
Appeal Brief

VI. Grounds of Rejection to be Reviewed on Appeal

- A. **Claims 1-4, 23-27, and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mola et al., U.S. Patent No. 6,125,030.**
- B. **Claims 5-7 and 28-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mola in view of Funk et al., U.S. Patent No. 6,681,176.**

Appellant appeals from these grounds of rejection.

VII. Argument

A. Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). More specifically, "Federal Circuit decisions repeatedly emphasize that anticipation (lack of novelty) is established only if (1) all the elements of an invention, as stated in a patent claim, (2) are identically set forth, (3) in a single prior art reference". Chisum on Patents § 3.02. *See also* Gechter v. Davidson, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) ("Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.").

B. Obviousness

Obviousness can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has the benefit of the applicant's disclosure as a blueprint and guide. In contrast, one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection.

For these reasons, the law places upon the Examiner the initial burden of establishing a *prima facie* case of obviousness. If the Examiner fails to establish the requisite *prima facie* case, the

Appeal of U.S. Application No. 10/663,045
Appeal Brief

rejection is improper and will be overturned. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993). Only if the Examiner’s burden is met does the burden shift to the Applicant to provide evidence to refute the rejection.

In meeting this initial burden, the Examiner “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Thus, the Examiner is required to perform the “critical step” of casting his or her mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See, e.g., W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

Three criteria must be satisfied by the Examiner in order to establish a *prima facie* case of obviousness: (1) there must be some reasoning, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the combination of references must teach or suggest all the claim limitations. *See MPEP § 706.02(j)*, *citing In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Rejections on obviousness grounds also cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006). The factual inquiry performed by the Examiner in issuing an obviousness rejection must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). The prohibition against conclusory examination is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision-making, as it is in § 103. *In re Kahn*, 441 F.3d at 988.

“As is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) (Referring to *United States v.*

Appeal of U.S. Application No. 10/663,045
Appeal Brief

Adams, 383 U. S. 39, 40 (1966)). Rather, there must be some “reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit”. *Id.* (Citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

Consequently, an Examiner’s mere identification in the prior art of each individual element claimed is insufficient to defeat the patentability of a claimed invention without a proper reasoning to combine or modify the elements. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125 (Fed. Cir. 1984).

In presenting the reasoning to combine prior art references, the Examiner may not resort to broad and conclusory statements; as such statements are not “evidence” of anything. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The reasoning to make the claimed combination must be found in the prior art, not in the applicant’s disclosure. *In re Vaeck*, 947 F.2d at 490. If the Examiner’s proposed combination renders the prior art invention unsatisfactory for its intended purpose, or changes its principal of operation, there can be no reasoning to form the combination—and thus no *prima facie* case of obviousness. See MPEP § 2143.01; *In re Gordon*, 733 F.2d at 902.

C. Summary of Arguments

The cited references fail to teach each and every claim limitation. Furthermore, the cited references explicitly teach away from the currently pending claims. Therefore, there exists no reasoning to combine the references in the proposed manner since the references themselves teach away from such a combination. Thus, the Examiner has failed to establish a *prima facie* case of obviousness, much less anticipation, and the present rejections cannot be sustained.

D. Summary of the References

Mola teaches an overhead console that is specifically designed to hide his navigation unit. *See Abstract.* When Mola's door is open, his navigation unit is not within his console. Only when Mola's door is closed is his navigation unit within his console. However, in this state, Mola's console is specifically designed to hide his navigation unit. Mola's entire invention is designed to hide his navigation unit when folded within. *See Abstract.*

Funk is merely cited as teaching a GPS device with a battery, data connections, and headphones.

E. The rejection of claims 1-4, 23-27, and 30 under 35 U.S.C. § 102(b) as being anticipated by Mola et al., U.S. Patent No. 6,125,030.

1. Claims 1 and 24

Claim 1 recites “a portable navigational device” and “a mounting assembly for mounting on a support pillar of the vehicle and sized and configured to removably receive the navigational device, *wherein the navigation device remains visible when received within the mounting assembly* and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly”, emphasis added. Claim 24 recites “a stand-alone hand-held portable navigational device” and “a mounting assembly for mounting on an existing support pillar of the vehicle and sized and configured to mate with the support pillar and removably receive the navigational device, *such that the navigation device remains visible and fully functional when received within the mounting assembly*”, emphasis added.

The Examiner asserts that “received could mean attached to the hinged door ... not necessarily closed into the roof as applicant is suggesting”. Page 2 of the July 19, 2007 Final Office Action. However, such argument ignores the plain meaning of the language of the claims.

Specifically, there is a fundamental difference between “received within”, as described in the present specification and claimed in the claims, and ‘attached to’, as shown in the cited prior art. For example, the Encarta® World English Dictionary, North American Edition defines ‘within’ as “used

Appeal of U.S. Application No. 10/663,045
Appeal Brief

to indicate that somebody or something is inside or enclosed by a place, area, or object”. Merriam-Webster’s Online Dictionary, 10th Edition, defines ‘within’ as “in or into the interior”. The American Heritage® Dictionary of the English Language defines ‘within’ as “In or into the inner part; inside”. These definitions are consistent with the description in the specification, illustration in the drawings, and usage in the claims. In contrast, the only position Mola describes, in which his device would be “enclosed”, “in the interior”, or in any way “inside”, would be his closed position shown in Figure 4. Therefore, Applicant’s arguments are consistent with the present specification, common usage of the claim language, and the prior art’s explicit teachings.

Furthermore, as discussed above, Mola’s entire purpose is to hide the device when received within his mounting system. *See Abstract*. Finally, any modification of Mola, to make his device visible and/or functional when “received within” his mount would necessarily defeat his explicit purpose. Thus, Mola neither discloses, suggests, or makes obvious the currently pending claims.

2. Claims 4 and 27

Claim 4 recites “a docking station mounted within the base” and “a retractable face plate mounted within the docking station”. Claim 27 recites “a docking station mounted within the base and designed to conform to the shape of the navigation device”.

The Examiner asserts that Mola’s unnumbered cavity “seems to” meets this limitation. Page 2 of the July 19, 2007 Final Office Action. However, a cavity is not **mounted**, nor is a cavity **designed** to conform to anything. In fact, Mola’s overhead console appears completely conventional, and therefore cannot be specifically “designed to conform to the shape of the navigation device”. Furthermore, the docking station described in the specification and claimed in the claims is a tangible physical object. *See* Pages 25-26, and Item 200k of Figure 22, of the specification. In contrast, a cavity is not a tangible physical object, nor can it be analogous to one. Thus, Mola’s cavity cannot anticipate this limitation. As a result, Mola does not anticipate the currently pending claims and the present rejections cannot be sustained.

Appeal of U.S. Application No. 10/663,045
Appeal Brief

With regard to claim 4, the Examiner also asserts that Mola's door 22 is analogous to the claimed "a retractable face plate mounted within the docking station". Page 4 of the July 19, 2007 Final Office Action. However, such a position is inconsistent with the position the Examiner has taken with respect to claim 1. Specifically, the only position in which Mola's door is mounted *within* his cavity, is when the door is closed. In this position, Mola's navigation device would be hidden, as is his explicit purpose, and therefore the Examiner's interpretation of Mola cannot meet the limitations of claim 4, much less in combination with the limitations of claim 1.

3. Claims 23 and 26

Claim 23 recites "wherein the support pillar runs along and directly above the vehicle's windshield". Claim 26 recites "wherein the support pillar is a pillar directly above and runs along the vehicle's windshield". Nothing in Mola suggests mounting anything to a support pillar running "along the vehicle's windshield". As a result, Mola does not anticipate the currently pending claims and the present rejections cannot be sustained.

The Examiner argues that "the width of Mola's base 12 is substantially parallel to the width of the windshield". Page 4 of the July 19, 2007 Final Office Action. While that is certainly true, it does not meet the limitations of the currently pending claims. For example, the Encarta® World English Dictionary, North American Edition defines 'along' as "parallel with". Merriam-Webster's Online Dictionary, 10th Edition, defines 'along' as "in a line matching the length or direction of". The American Heritage® Dictionary of the English Language defines 'along' as "[o]n a line or course parallel and close to; continuously beside". These definitions were presented and entered into the record with the August 22, 2007 Amendment. These definitions are consistent with the description in the specification, illustration in the drawings, and usage in the claims. Figure 19 is particularly illustrative.

One of ordinary skill in the art, armed with these definitions, would expect that the term "runs along" refers to the longest axis of each object. Here, the Examiner refers to the width of Mola's console, which is clearly not its longest axis, and the width of a windshield, which would

Appeal of U.S. Application No. 10/663,045
Appeal Brief

clearly be the longest axis of the windshield. Thus, rather than running along, or parallel as the term is best understood, one with ordinary skill in the art would describe the relationship shown in Mola as perpendicular. Thus, one with ordinary skill in the art would not consider Mola's console to "run along" "the vehicle's windshield, as claimed. As a result, Mola does not disclose, suggest, or make obvious the currently pending claims.

4. Claims 2, 3, 25, and 30

The remaining claims all depend directly or indirectly from independent claims 1 or 24, and are therefore also allowable.

F. The Rejection of claims 5-7 and 28-29 under 35 U.S.C § 103(a) as being unpatentable over Mola in view of Funk et al., U.S. Patent No. 6,681,176.

1. Claim 6

Claim 6 recites "wherein the docking station includes a speaker".

The Examiner acknowledges that Mola fails to teach this limitation. Page 6 of the March 9, 2007 Office Action. In an attempt to cure this defect, the Examiner points to Funk's teaching of a possible speaker in his hand-held unit 42. However, neither prior art reference teaches a speaker *in a docking station*, as claimed. Rather, Funk teaches a removable faceplate, which is primarily designed as part of an in-dash vehicle stereo and navigation system. Such an in-dash system would certainly use speakers mounted throughout the vehicle, rather than any including with any docking station. Additionally, those speakers would not be part of his faceplate. Furthermore, in column 5, lines 19-20, Funk teaches "[t]he speaker (not shown) may be either a built-in speaker or may be a headphone or ear bud". The "built-in speaker" Funk refers to can only be traditional speakers mounted throughout the vehicle, but that would not be part of any docking station or his faceplate. Finally, headphones or an ear bud could not possibly be enclosed within his docking station, or dashboard receptacle, as it is designed to tightly accept his faceplate, leaving no room for the

Appeal of U.S. Application No. 10/663,045
Appeal Brief

addition of headphones or an ear bud. Thus, the Examiner has failed to cite a reference that teaches this limitation. As a result, the present rejection cannot be sustained.

In summation, neither Mola nor Funk teaches “wherein the docking station includes a speaker”, as claimed in claim 6. For example, the Examiner asserts that Mola’s cavity is analogous to the claimed docking station. However, nowhere does Mola teach his cavity including a speaker. Similarly, Funk’s only component that might be analogous to the claimed docking station is his dashboard receptacle. However, nowhere does Funk teach his dashboard receptacle including a speaker. Rather, Funk teaches traditional speakers mounted throughout the vehicle or external headphones. As a result, no combination of Mola and Funk discloses, suggests, or makes obvious “wherein the docking station includes a speaker”, as claimed in claim 6.

2. Claims 5, 7, 28, and 29

The remaining claims all depend directly or indirectly from independent claims 1 or 24, and are therefore also allowable.

VIII. Conclusion

The Examiner failed, with regard to the rejection of the pending claims under 35 U.S.C. §103(a), to establish the requisite *prima facie* case of obviousness because the cited prior art fails to teach each and every claim limitation. Furthermore, the cited prior art actually teaches away from the Examiner’s proposed combination, and therefore there can be no reasoning to combine the references. Consequently, the Examiner failed to establish the requisite *prima facie* case of obviousness, and the rejections under 35 U.S.C. § 103 cannot be sustained and must be overturned.

Accordingly, reversal of the Examiner’s rejections is proper, and such favorable action is solicited.

Appeal of U.S. Application No. 10/663,045
Appeal Brief

Respectfully submitted,

By: /Samuel M. Korte/
Samuel M. Korte, Reg. No. 56,557
Garmin International, Inc.
1200 East 151st Street
Olathe, KS 66062
(913) 440-5421
(913) 397-9079 (Fax)

VIII. Claims Appendix

1. (Previously Presented) A navigation assembly for use in a vehicle not originally equipped with navigational capabilities, the navigation assembly comprising:
 - a portable navigational device; and
 - a mounting assembly for mounting on a support pillar of the vehicle and sized and configured to removably receive the navigational device, wherein the navigation device remains visible when received within the mounting assembly and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly.
2. (Previously Presented) The navigation assembly as claimed in claim 1, wherein the navigational device is designed to be used independently of the vehicle rather than being particularly sized and configured to fit an existing space within the vehicle.
3. (Original) The navigation assembly as claimed in claim 2, wherein the support pillar is a pillar directly above the vehicle's windshield.
4. (Original) The navigation assembly as claimed in claim 3, wherein the mounting assembly includes -
 - a trim piece,
 - a base secured to the trim,
 - a docking station mounted within the base, and
 - a retractable face plate mounted within the docking station.

Appeal of U.S. Application No. 10/663,045
Appeal Brief

5. (Original) The navigation assembly as claimed in claim 4, the mounting assembly further including electrical connections for connecting the navigational device to a power source and a data source supplied by the vehicle.

6. (Original) The navigation assembly as claimed in claim 5, wherein the docking station includes a speaker for providing audible navigation instructions.

7. (Original) The navigation assembly as claimed in claim 6, wherein the navigational device is a global positioning satellite device including -

- a navigation component,
- a processor coupled with the navigation component,
- a memory coupled with the processor,
- a display,
- an input, and

a housing for housing the navigation component, the processor, and the memory.

23. (Previously Presented) The navigation assembly as claimed in claim 1, wherein the support pillar runs along and directly above the vehicle's windshield.

24. (Previously Presented) A navigation assembly for use in a vehicle not originally equipped with navigational capabilities, the navigation assembly comprising:

- a stand-alone hand-held portable navigational device; and
- a mounting assembly for mounting on an existing support pillar of the vehicle and sized and configured to mate with the support pillar and removably receive the navigational device, such that the navigation device remains visible and fully functional when received within the mounting assembly.

Appeal of U.S. Application No. 10/663,045
Appeal Brief

25. (Previously Presented) The navigation assembly as claimed in claim 24, wherein the navigational device is designed to be used independently of the vehicle rather than being particularly sized and configured to fit an existing space within the vehicle.

26. (Previously Presented) The navigation assembly as claimed in claim 24, wherein the support pillar is a pillar directly above and runs along the vehicle's windshield.

27. (Previously Presented) The navigation assembly as claimed in claim 24, wherein the mounting assembly includes -

a trim piece,

a base secured to the trim,

a docking station mounted within the base and designed to conform to the shape of the navigation device, and

a retractable face plate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station.

28. (Previously Presented) The navigation assembly as claimed in claim 27, wherein the docking station includes a speaker for providing audible navigation instructions.

29. (Previously Presented) The navigation assembly as claimed in claim 24, wherein the mounting assembly includes electrical connections for connecting the navigational device to a power source and a data source supplied by the vehicle.

Appeal of U.S. Application No. 10/663,045
Appeal Brief

30. (Previously Presented) The navigation assembly as claimed in claim 24, wherein the navigational device is a global positioning satellite device including -

- a navigation component,
 - a processor coupled with the navigation component,
 - a memory coupled with the processor,
 - a display,
 - an input, and
- a housing for housing the navigation component, the processor, and the memory.

Appeal of U.S. Application No. 10/663,045
Appeal Brief

IX. Evidence Appendix

None.

Appeal of U.S. Application No. 10/663,045
Appeal Brief

X. Related Proceedings Appendix

U.S. Patent Application entitled “NAVIGATIONAL DEVICE FOR INSTALLATION IN A VEHICLE AND A METHOD OF DOING SAME”, Serial No. 11/051,879, filed February 5, 2005 is related to the instant application and is also under Appeal. No decision has been rendered by the Board in this related case and thus there is no related proceeding appendix included with this Brief.